UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/016,599	12/10/2001	Nicole A. Nemer	SMQ-066/P5901	6538

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EXAMINER
KISS, ERIC B

ART UNIT	PAPER NUMBER
2122	

DATE MAILED: 12/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<table>
<tr><td rowspan="2">Office Action Summary</td><td>Application No.
10/016,599</td><td>Applicant(s)
NEMER, NICOLE A.</td></tr>
<tr><td>Examiner
Eric B. Kiss</td><td>Art Unit
2122</td></tr>
</table>

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>10 December 2001</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-20</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-20</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on <u>09 July 2002</u> is/are: a)☐ accepted or b)☒ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

1.   Claims 1-20 have been examined.

Specification

2.   The use of the trademarks JAVA and SOLARIS has been noted in this application. They should be capitalized wherever they appear (capitalize each letter or include an appropriate trademark designation, *e.g.*, "SOLARIS" or "Solaris™") and be accompanied by the generic terminology (use each trademark as an adjective modifying a descriptive noun, *e.g.*, "the JAVA programming language". Note that "programming language" provides appropriate generic terminology).

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks. Applicant is encouraged to review the document, "Sun Trademark and Logo Usage Requirements," available on the World Wide Web at URL: <http://www.sun.com/policies/trademarks/>. This document specifies, in greater detail, appropriate usage of the cited trademarks of Sun Microsystems, Inc.

3.   The title is objected to because the use of a trademark in the title of an application should be avoided. See MPEP §608.01(v).

Drawings

4.   The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they

include the following reference character(s) not mentioned in the description: "70" in Fig. 3.

Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the

specification to add the reference character(s) in the description in compliance with 37 CFR

1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any

amended replacement drawing sheet should include all of the figures appearing on the immediate

prior version of the sheet, even if only one figure is being amended. The replacement sheet(s)

should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to

obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the

applicant will be notified and informed of any required corrective action in the next Office

action. The objection to the drawings will not be held in abeyance.

Claim Objections

5.   Claim 20 is objected to because of the following informalities: "he" in line 1 should read

--The--. Appropriate correction is required.

Claim Rejections - 35 USC § 112

6.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7.   Claims 1-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1-20 contains the trademark/trade name JAVA. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe a particular computer software product and, accordingly, the identification/description is indefinite. In the interest of compact prosecution, the term "Java", as recited in the claims, is interpreted as referring to an object-oriented programming language for the purpose of further examination. Note that this interpretation is applied merely to assign an ascertainable scope to the claims and is not intended to be a suggestion that the term "Java" is a generic name used in trade.

Claim Rejections - 35 USC § 101

8.   35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

9.   Claims 1-20 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

As per claims 1-8 and 16-20, the statutory category of these claims is unclear, i.e., it is unclear whether the claims are directed toward a process or a machine. The bodies of claims 1 and 16, and the dependent claims 2-6, 8, and 17-20, appear to define method steps (a process), but the preambles of claims 1 and 16, and the body of dependent claim 7, appear to define an electronic device (a machine). It is noted that if Applicant intends these claims to define a machine, then they are not specified in a statutory manner, as there is no nexus between the prescribed functionality and the operation of the machine. For example, if the method steps are intended to be the result of executing instructions on a computer system, then the claims need to specify this functional interrelationship in order to recite a statutory machine. If Applicant intends these claims to define a statutory process, then reference to the electronic device should be removed, and additionally, claim 7 should be cancelled as further defining the electronic device fails to further define the method.

As per claims 9-15, the medium specified in these claims is not specifically within the technological arts, and can, for example, describe a piece of paper with printed instructions thereon. Without specifying a proper functional interrelationship between the data stored on the medium and a machine, such that the data is capable of being executed by the machine to cause a functional change in the machine, the claims merely define non-functional descriptive material, per se, which is not statutory.

10.   To expedite a complete examination of the instant application, the claims rejected under 35 U.S.C. §101 (non-statutory) above are further rejected as set forth below in anticipation of Applicant amending these claims to place them within the four statutory categories of invention.

Claim Rejections - 35 USC § 102

11.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

12.   Claims 1-20 are rejected under 35 U.S.C. 102(a) as being anticipated by the Jato API disclosed by Andy Krumel in "Jato: The new kid on the open source block, Part 1" (March 2001; hereinafter *JATO_One*), "Jato: The new kid on the open source block, Part 2" (April 2001;

hereinafter *JATO_Two*), and "Jato: The new kid on the open source block, Part 3" (May 2001; hereinafter *JATO_Three*), said API hereinafter *JATO*.

As per claim 1, *JATO* is disclosed as providing a base object class that includes at least one method for converting between "Java" objects and XML data objects (see, for example, "Jato architecture on pp. 2-3 of *JATO_One*); providing a selected object class that is a sub-class of the base object class (see, for example, "Jato architecture" on pp. 2-3 of *JATO_One*; and "Java-to-XML example" and "XML-to-Java example" on pp. 4-9 of *JATO_One*); and for a given instance of the selected object class, invoking the method to perform a conversion on the given instance (see, for example, "Java-to-XML example" and "XML-to-Java example" on pp. 4-9 of *JATO_One*).

As per claim 2, *JATO* is further disclosed as the selected object class being a "Java" object class (see, for example, "Java-to-XML example" on pp. 4-8 of *JATO_One*).

As per claim 3, *JATO* is further disclosed as the selected object class being an XML data object class (see, for example, "XML-to-Java example" on pp. 8-9 of *JATO_One*).

As per claim 4, *JATO* is further disclosed as the method for converting being invoked to convert a "Java" object into at least one XML data object (see, for example, "Java-to-XML example" on pp. 4-8 of *JATO_One*).

As per claim 5, *JATO* is further disclosed as the method for converting being invoked to convert an XML data object into "Java" (see, for example, "XML-to-Java example" on pp. 8-9 of *JATO_One*).

As per claim 6, *JATO* is further disclosed as the method for converting being invoked to convert an entire XML document into "Java" (see, for example, "XML-to-Java example" on pp. 8-9 of *JATO_One*).

As per claim 7, *JATO* is further inherently disclosed as using a computer system to realize the prescribed method steps.

As per claim 8, *JATO* is further disclosed as the base object class including both a method for converting from "Java" to XML and a method for converting from XML to "Java" (see, for example, "Jato architecture" on pp. 2-3 of *JATO_One*; and "Java-to-XML example" and "XML-to-Java example" on pp. 4-9 of *JATO_One*).

As per claims 9-15, these are medium versions the prescribed method steps discussed above (claims 1-6 and 8, respectively). The use of such a medium, such as memory, is inherent in performing the computer-implemented steps discussed above.

As per claim 16, *JATO* is disclosed as providing a base object class that includes at least one method for converting between "Java" objects and XML data objects (see, for example, "Jato architecture" on pp. 2-3 of *JATO_One*; and "Java-to-XML example" and "XML-to-Java example" on pp. 4-9 of *JATO_One*); defining a first object class as a sub-class of the base object class (see, for example, "Jato architecture" on pp. 2-3 of *JATO_One*); and defining a second object class as a sub-class of the base object class (see, for example, "Jato architecture" on pp. 2-3 of *JATO_One*).

As per claim 17, *JATO* is further disclosed as, for an instance of the first object class, invoking the method for converting to perform conversion of the instance of the first object class

(see, for example, "Jato architecture" on pp. 2-3 of *JATO_One*; and "Java-to-XML example" and "XML-to-Java example" on pp. 4-9 of *JATO_One*).

As per claim 18, *JATO* is further disclosed as, for an instance of the second object class, invoking the method for converting to perform conversion of the instance of the second object class (see, for example, "Jato architecture" on pp. 2-3 of *JATO_One*; and "Java-to-XML example" and "XML-to-Java example" on pp. 4-9 of *JATO_One*).

As per claim 19, *JATO* is further disclosed as the "method for converting" converting a "Java" object into XML (see, for example, "Jato architecture" on pp. 2-3 of *JATO_One*; and "Java-to-XML example" on pp. 4-8 of *JATO_One*).

As per claim 20, *JATO* is further disclosed as the "method for converting" converting an XML document into "Java" (see, for example, "Jato architecture" on pp. 2-3 of *JATO_One*; and "XML-to-Java example" on pp. 8-9 of *JATO_One*).

Conclusion

13.   The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

14.   Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Eric B. Kiss whose telephone number is (571) 272-3699. The Examiner can normally be reached on Tue. - Fri., 7:00 am - 4:30 pm. The Examiner can also be reached on alternate Mondays.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's

supervisor, Tuan Dam, can be reached on (571) 272-3695. The fax phone number for the

organization where this application or proceeding is assigned is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

EBK /EBK
November 22, 2004

WEI Y. ZHEN
PRIMARY EXAMINER